

BY FACSIMILE ONLY

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

March 11, 2003

Opposition No. 91150094

Old World Industries,
Inc. and
Splitfire International,
Inc.

v.

Auto Meter Products,
Inc.

David Mermelstein, Attorney:

By consent motion filed on December 20, 2002, and approved by the Board on January 3, 2003, opposer's rebuttal testimony period was set to close on March 21, 2003. Now before the Board is applicant's motion to quash the notice of testimonial deposition of Ram Date, an expert witness for opposer, scheduled to be held on March 14, 2003.

Notice of Mr. Date's deposition was provided to applicant on February 25, 2003.¹ A letter accompanying the notice of deposition indicates that opposer "anticipate[s] that Mr. Date will testify concerning functionality."

Applicant now moves to quash the notice on two grounds:

(1) Because opposer had not identified Mr. Date or provided any information about the substance of his testimony during

¹ The copy of the notice of deposition provided by applicant did not include a certificate of service. However, applicant

discovery (pursuant to applicant's discovery requests); and (2) because Mr. Date's testimony should have been put on in opposer's case-in-chief, and is therefore improper rebuttal.

Applicant requested that the Board hold a telephone conference on the motion, due to the exigency of the matter. The Board agrees. A telephone conference was held on March 11, 2003, to hear argument on the motion. Participating were Philip T. Petti and Sandra V. Scavo for applicant, Sanjiv D. Sarwate, for opposer, and the above-identified Board attorney.

The question, it seems, comes down to precisely what Mr. Date's testimony will actually be.

If, on the one hand, Mr. Date's testimony is truly rebuttal, that is "facts and witnesses appropriate to deny, explain or otherwise discredit the facts and witnesses of applicant," *The Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1469 (TTAB 1990), then it is not only proper rebuttal, but it is also at least questionable whether applicant had the obligation to disclose Mr. Date's identity and proposed testimony earlier.² On the other hand, if Mr. Date's testimony consists of matter which

acknowledges receipt of the paper and does not contend that the notice was improper for this reason.

² During the telephone conference, opposer stated that it had not retained Mr. Date until after close of the discovery period, but that it had not served a supplemental response to applicant's discovery requests directed to expert witnesses. We need not decide here whether opposer is substantially relieved of its

should have been raised during opposer's case-in-chief, it is infirm on both grounds.³

The problem is that in order to determine whether Mr. Date's testimony is proper rebuttal, we would not only have to examine applicant's testimony and evidence, but also Mr. Date's testimony as well. By long standing practice, the Board will not delve into the substance of evidence or testimony prior to final consideration of the case, and needless to say, we cannot consider Mr. Date's testimony before it is taken.

While we have serious concerns regarding Mr. Date's testimony, it is impossible to say at this point in the proceeding that it is necessarily improper. Accordingly, applicant's motion to quash is DENIED. We hasten to add, however, that this ruling is without prejudice to applicant's right to move to strike the testimony if such a motion appears appropriate after the testimony is taken and filed. Such a motion should be raised in applicant's brief

usual obligations to respond to discovery by choosing not to hire an expert until after applicant's trial period.

³ Opposer's suggestion during the telephone conference that it would be proper to present no more than a *prima facie* case during its case-in-chief, reserving the remainder of its direct evidence for the rebuttal period is not well-taken. Applicant has a right to respond to opposer's direct evidence, and the rebuttal period is, not surprisingly, for rebuttal. The Board's discovery and trial rules - like those in civil proceedings - are designed to facilitate the orderly resolution of disputes, and should not be used as a means to "sandbag" an opponent and conduct trial by surprise.

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on the case, and will be decided by a panel of the Board upon final consideration.

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